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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,787	07/05/2001	David Paul Felsher	FELSHER 201.1	2368
10037 7590 12/12/2007 MILDE & HOFFBERG, LLP 10 BANK STREET SUITE 460 WHITE PLAINS, NY 10606			EXAMINER SHERR, CRISTINA O	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 12/12/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/899,787

Applicant(s)

FELSHER, DAVID PAUL

Examiner

Cristina Owen Sherr

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-151 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-151 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to applicant's amendment filed July 19, 2007. Claims 1-151 are currently pending in this case. Claim 144 has been amended.

Election/Restrictions

2. Applicant's response to the election/restriction requirement issued on July 16, 2007 is hereby acknowledged, and the said requirement hereby withdrawn.

Response to Arguments

3. Applicant's arguments filed February 16, 2007 have been fully considered but they are not persuasive.
4. Applicant argues, with respect to all the claims, that nothing in the cited prior art discloses, teaches, or suggest limiting the claims by the creation of a legal trust.
5. We note firstly:

trust

n. an entity created to hold assets for the benefit of certain persons or entities, with a trustee managing the trust (and often holding title on behalf of the trust). (law.com Dictionary, at <http://dictionary.law.com>).

6. Therefore in creating a trust, the claims are merely implementing a certain set of rules for access to the records. Whether we choose legal trust rules or any other rules, immaterial. The fact is that rules are chosen and implemented. In providing for access via certain keys and a certain data signature, in order to ensure that only authorized

handler access records, Rusnak (see, e.g., abstract) is choosing and implementing certain rules for access to the stored records. In other words, the fact of a trust rather being created rather than any other set of access rules is nonfunctional descriptive material. Thus, it would be obvious to a practitioner of ordinary skill in the art at the time the invention was made to adapt Rusnak in order to obtain the instant application. We further note, that, in and of themselves, legal trusts are old and well known.

7. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in Benson were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”). Such a result would exalt form over substance. In re *Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-151 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rusnak et al (US 6,098,056).

10. Regarding claim 1 –

Rusnak discloses a method, comprising the steps of:

defining a plurality of records; (col 5 ln 30-35)
qualifying an access to a record by referencing a respective set of access rules for the record,(e.g. col 5 ln 33-35) said respective access rules being stored in a database representing respective sets of access rules for said plurality of records, (e.g. col 4 ln 65- col 5 ln 3) and said respective set of access rules comprising instructions to a trustee (col 4 ln 28-32, where trustee = “trusted information handler” or TIH) on behalf of a beneficiary (“owner” col 45 ln 30-35); and applying the respective set of access rules, retrieved from the database, to selectively grant access to the record by a third party, by means of an automated system (Col 5 ln 52-65).

11. As above, whether we choose legal trust rules or any other rules, is immaterial. The fact is that rules are chosen and implemented. In providing for access via certain keys and a certain data signature, in order to ensure that only authorized handler access records, Rusnak (see, e.g., abstract) is choosing and implementing certain rules for access to the stored records. In other words, the fact of a trust rather being created rather than any other set of access rules is nonfunctional descriptive material. Thus, it would be obvious to a practitioner of ordinary skill in the art at the time the invention was

made to adapt Rusnak in order to obtain the instant application. We further note, that, in and of themselves, legal trusts are old and well known.

12. Regarding claim 2 –

Rusnak discloses the method according to claim 1, wherein the record is encrypted, further comprising the step of accounting for a decryption of the record after access to at least a portion thereof. (e.g. col 5 ln 30-35).

13. Regarding claim 3 –

Rusnak discloses the method according to claim 2, wherein said accounting is anonymous. (e.g. col 5 ln 35-40)

14. Regarding claim 4 –

Rusnak discloses the method according to claim 1, wherein the record has a plurality of portions, at least one portion being encrypted with at least one cryptographic key, said portions being independently accessible, said respective set of access rules applying to selectively limit access to portions of the record. (e.g. col 6 ln 22-35).

15. Regarding claim 5 –

Rusnak discloses the method according to claim 4, wherein said respective set of access rules limit access to portions based on an identity of an intended recipient (e.g. col 6 ln 25-35).

16. Regarding claim 6 –

Rusnak discloses the method according to claim 1, further comprising the step of supplying a decryption key for a respective record portion in accordance with the respective set of access set of rules. (e.g. col 6 ln 35-39).

17. Regarding claim 7 –

Rusnak discloses the method according to claim 1, further comprising the step of accounting for attempted access to at least a portion of the record. (col 3 ln 10-21).

18. Regarding claim 8 –

Rusnak discloses the method according to claim 1, wherein the respective set of access rules are associated with an intended recipient of the record. (col 5 ln 55-58).

19. Regarding claim 9 –

Rusnak discloses the method according to claim 1, further comprising the step of referencing an index to define a record. (col 6 ln 12-17).

20. Regarding claim 10 –

Rusnak discloses the method according to claim 9, wherein the index further stores a set of access rules for qualifying an intended recipient with respect to each of the records. (e.g. col 5 ln 49-52).

21. Regarding claim 11 –

Rusnak discloses the method according to claim 1, further comprising the step of using an index to identify a record potentially responsive to a query. (col 4 ln 20-25).

22. Regarding claim 12 –

Rusnak discloses the method according to claim 1, further comprising the step of using an index comprising a set of associations of owner identities and transaction records to identify records relating to a respective owner. (col 4 ln 20-25). Although Rusnak does not disclose medical records specifically, medical records are just one more type of digital data or digital record and would be handled in the same manner.

23. Regarding claim 13 –

Rusnak discloses the method according to claim 1, further comprising the step of using an index comprising a set of associations of record identification, record characteristic, and said access rules to identify records relating to a query and limiting access to portions thereof. (col 4 ln 20-25).

24. Regarding claim 14 –

Rusnak discloses the method according to claim 1, wherein the record comprises a plurality of portions, the portions being separately encrypted and having associated sets of independent rules. (col 4 ln 10-15).

25. Regarding claim 15 –

Rusnak discloses the method according to claim 1, wherein the access rules are role based access rules relating to a role of the intended recipient. (e.g. col 6 ln 22-35).

26. Regarding claim 16 –

Rusnak discloses the method according to claim 1, wherein the access rules are context based access rules relating to a context of record access. (e.g. col 6 ln 22-35).

27. Regarding claim 17 –

Rusnak discloses the method according to claim 1, wherein the respective set of access rules are defined by a grantor of the trust. (col 5 ln 43-48).

28. Regarding claim 18 -

Rusnak discloses the method according to claim 1, wherein the record is encrypted, and a decryption of the record triggers a remotely-sensed transaction. (e.g. claim 16)

29. Regarding claim 19 –

Rusnak discloses the method according to claim 18, wherein the remotely sensed transaction comprises a financial accounting transaction. (e.g. claim 16)

30. Regarding claim 20 –

Rusnak discloses the method according to claim 18, wherein the remotely sensed transaction comprises an access audit trail transaction. (e.g. claim 6)

31. Regarding claim 31 –

Rusnak discloses the method according to claim 2, wherein said accounting occurs upon supply of the respective decryption key. (e.g. claim 16).

32. Regarding claim 22 –

Rusnak discloses the method according to claim 2, wherein said accounting occurs upon use of the respective decryption key. (e.g. claim 16).

33. Regarding claims 23-24 –

As above, although Rusnak does not disclose medical records or media access records specifically, such records are just one more type of digital data or digital record and would be handled in the same manner.

34. Regarding claims 25, 26, 27 –

As above, whether we choose legal trust rules or any other rules, is immaterial. The fact is that rules are chosen and implemented. In providing for access via certain keys and a certain data signature, in order to ensure that only authorized handler access records, Rusnak (see, e.g., abstract) is choosing and implementing certain rules for access to the stored records. In other words, the fact of a trust rather being created rather than any other set of access rules is nonfunctional descriptive material. Thus, it

would be obvious to a practitioner of ordinary skill in the art at the time the invention was made to adapt Rusnak in order to obtain the instant application. We further note, that, in and of themselves, legal trusts are old and well known.

35. Regarding claim 28 –

As above, although Rusnak does not disclose specifically articles within a publication, such records are just one more type of digital data or digital record and would be handled in the same manner.

36. Regarding claim 29 –

Rusnak discloses the method according to claim 1, further comprising the step of receiving the respective set of access rules. (e.g. col 5 ln 44-49).

37. Regarding claim 30 –

Rusnak discloses the method according to claim 1, further comprising the step of generating the respective set of access rules based on the record. (e.g. col 5 ln 44-49).

38. Regarding claim 31 –

Rusnak discloses the method according to claim 1, wherein the record is encrypted with an encryption scheme having a rolling code. (e.g. col 4 ln 60-65).

39. Regarding claim 32 –

Rusnak discloses the method according to claim 1, wherein the trustee controls the records and implements the access rules without requiring access to a content of the records. (e.g. col 6 ln 25-35).

40. Regarding claim 33 –

Rusnak discloses the method according to claim 1, wherein the trustee acts without requiring access to the records. (e.g. col 6 ln 25-35).

41. Regarding claim 34 –

Rusnak discloses the method according to claim 1, wherein the trustee selectively processes the records. (e.g. col 6 ln 25-35).

42. Regarding claims 35-143 –

As above, although Rusnak does not disclose specifically the types of records in claim 35, such records are just one more type of digital data or digital record and would be handled in the same manner. And further, whether we choose legal trust rules or any other rules, is immaterial. The fact is that rules are chosen and implemented. In providing for access via certain keys and a certain data signature, in order to ensure that only authorized handler access records, Rusnak (see, e.g., abstract) is choosing and implementing certain rules for access to the stored records. In other words, the fact of a trust rather being created rather than any other set of access rules is nonfunctional descriptive material. Thus, it would be obvious to a practitioner of ordinary skill in the art at the time the invention was made to adapt Rusnak in order to obtain the instant application. We further note, that, in and of themselves, legal trusts are old and well known.

43. Regarding claim 144 –

Rusnak discloses a method, comprising the steps of: storing a set of access rules in a database (col 4 ln 65-col 5ln3);

defining a plurality of sets of information content, the sets of information content being subject to associated access rules stored in the database (col 5 ln 30-35);
transmitting information defining the associated access rules for the respective plurality of sets of information content to a trustee; (col 4 ln 28-32)

automatically, under control of the trustee, retrieving the associated access rules with respect to the associated information content, and implementing the retrieved associated access rules being implemented dependent on a context of attempted access of the associated information content,(e.g. col 5 ln 52-65)

44. As above, whether we choose legal trust rules or any other rules, is immaterial. The fact is that rules are chosen and implemented. In providing for access via certain keys and a certain data signature, in order to ensure that only authorized handler access records, Rusnak (see, e.g., abstract) is choosing and implementing certain rules for access to the stored records. In other words, the fact of a trust rather being created rather than any other set of access rules is nonfunctional descriptive material. Thus, it would be obvious to a practitioner of ordinary skill in the art at the time the invention was made to adapt Rusnak in order to obtain the instant application. We further note, that, in and of themselves, legal trusts are old and well known.

45. Regarding claim 145-151 –

As above, whether we choose legal trust rules or any other rules, is immaterial. The fact is that rules are chosen and implemented. In providing for access via certain keys and a certain data signature, in order to ensure that only authorized handler access records, Rusnak (see, e.g., abstract) is choosing and implementing certain rules for

access to the stored records. In other words, the fact of a trust rather being created rather than any other set of access rules is nonfunctional descriptive material. Thus, it would be obvious to a practitioner of ordinary skill in the art at the time the invention was made to adapt Rusnak in order to obtain the instant application. We further note, that, in and of themselves, legal trusts are old and well known.

46. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

47. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

48. Trust Operations (Monty P. Gregor, CTFA, © 2000 by the American Bankers Association).

49. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). 50. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In

the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

51. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 571-272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

52. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

53. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

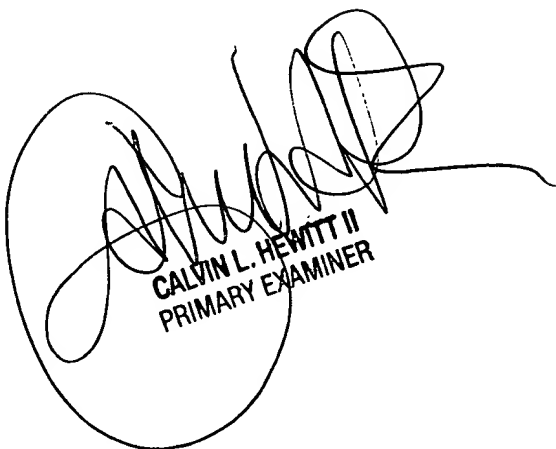
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Cristina Owen Sherr

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Patent Examiner, AU 3621


CALVIN L. HEWITT II
PRIMARY EXAMINER